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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/215,804 | 12/18/1998 | MARK GAVIN | D3239-00002 | 1595 |
| 8933 7590 04/17/2007 DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196 | | | EXAMINER BASHORE, WILLIAM L | |
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| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-10, 12-14, 16-18, 20-22, 24, 26-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, 12-14, 16-18, 20-22, 24, 26, 31-36 is/are rejected.
- 7) ☒ Claim(s) 27-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/14/2006, to the original application filed 12/18/1998.
2. Claims 1-6, 8-14, 16-22, 24, 26-34 pending. Claims 1, 5, 9, 13, 17, 21, 26 are independent claims.

Allowable Subject Matter

3. Claims 27-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4, 5-6, 9-10, 12, 17-18, 20, 26 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Redax (hereinafter Redax), Web article by Digital Applications, Inc., downloaded on 3/10/2005, with a last update of 12/13/1997, downloaded from <http://web.archive.org/web/19971221013620/http://digapp.com/>, pages 1-2, and further in view of Pontin, Jason, TechSmith ships Win95 screen capture utility, InfoWorld January 15, 1996, Vol. 18, Issue 3, pages 1-3.

In regard to independent claim 1, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble “*A method of redacting content from a document in electronic form, comprising the steps of*”).

Anderson does not specifically teach a PDF data stream. However, Redax teaches redaction as applied to a PDF file (Redax paragraph 1). It is noted that electronic PDF files generally comprise an underlying set of instructions that includes information on said PDF document content (i.e. location data of text and images, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax’s PDF file containing said instructions to Anderson’s document data stream, providing Anderson the benefit of redacting PDF documents, increasing the versatility of Anderson as applied to a wider variety of document types.

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 1 “*selecting a geometric area on the document for redaction, said geometric area having content comprising at least one image*”, and “*representing said geometric area as one or more annotation objects*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image/text objects, annotation/redaction area objects, etc.) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 “*identifying information in the document representing content and location and nature of content*”, and “*representing said identified*

information as one or more content objects, said one or more content objects comprising one or more image and text occurrence objects;”).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose *“an output file PDF file comprising said PDF stream except for portions of said PDF data stream corresponding to said identified content”* with said (image based) content not present, hence allowing a redacted document to be producible from said output file. However, as explained above, PDF files generally contain an underlying set of instructions (i.e. content, layout instructions, etc.). Redax page 1 paragraph 3, teaches opening a (PDF) document in Acrobat Exchange. The document is searched and words are tagged and overlayed with exemption codes. Since Redax teaches that a new (PDF) document is created and saved (reflective of user editing and redacted deleted text), said new edited document reflects a new set of saved instructions (exemption codes in place of the deleted data) accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax’s redaction method to Anderson’s data stream and redaction of text and images, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent PDF form for ultimate security (preventing document reverse-engineering, etc.).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 *“identifying content.....to produce a redacted document.”*).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47).

In regard to dependent claim 2, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 2).

In regard to dependent claim 4, Anderson/Pontin/Redax teaches a final-form document with annotated and/or redacted images/text are present in said document, said annotations permanently replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

In regard to claims 9-10, claims 9-10 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-2, respectively and are rejected along the same rationale.

In regard to claim 12, claim 12 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 4, and is rejected along the same rationale.

In regard to claims 17-18, 20, claims 17-18, 20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1, 2, 4, and are rejected along the same rationale.

In regard to independent claim 26, claim 26 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 31-34, Anderson does not specifically disclose replacement via "pixel by pixel". However, Anderson teaches images, and Redax teaches PDF (image based). Since modification of images in an electronic document generally involve modification of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification applied to a final output file (i.e. a PDF file), providing the benefit of image based redaction.

6. Claims 5-6, 8, 13-14, 16, 21-22, 24, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Pontin, Jason, TechSmith ships Win95 screen capture utility, InfoWorld January 15, 1996, Vol. 18, Issue 3, pages 1-3, and in view of Microsoft Word 97 - bundled with Microsoft Office 97 (hereinafter Word 97), application screenshots, pages 1-3, Microsoft Corporation, first released October 96.

In regard to independent claim 5, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble "*A method of designating portions of a document for redaction, comprising the steps of*").

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 "*displaying all or a portion of the document*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or redaction (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 5 "*designating a geographical region of the document for redaction*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose "saving" designations in association with the document, with said content not present, hence allowing a permanently redacted document to be producible from said

output file. However, Pontin teaches SnagIt 32, a screen capture utility (Pontin page 1, paragraph 1, 2). When SnagIt 32 captures Anderson's redacted document via screen shot capture, Anderson's possible redacted layers are "flattened" into an image file (Pontin page 2 paragraph 9 - .gif, jpeg, etc.). Since SnagIt also enables Microsoft Word to configure options and invoke captures via DDE (Dynamic Data Exchange) (Pontin page 2 paragraph 5), Anderson's document can be captured by Word (via invoking a SnagIt screenshot), and the (now flattened image) pasted as an image object into a document. It is noted that once a typical edited Word document is saved, document edits cannot be undone (up to the point of Save). Anderson's redacted image/document is now saved in permanently redacted form. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Pontin to Anderson, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent form for ultimate security (preventing document reverse-engineering, etc.). (compare with claim 5 "*saving the designations with the document*").

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4). Anderson also teaches an Image Object, and a Graphics Object, comprising geometric areas of a page (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line "Object Area Position"), teaching the manipulation and orientation (framing) of an object on a page.

Anderson does not specifically teach that the above frame is a "movable viewing" frame "superimposed" on the displayed document. However, Word 97 teaches a document comprising text and images (Word 97 page 1), whereby a user superimposes a rectangle via AutoShapes onto a displayed document (Word 97 page 2). Please note that said rectangle can be moved and resized accordingly (Word 97 page 3). It is also noted that said rectangle can be made transparent, or semi-transparent (Word 97 pages 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the movable/resizable rectangle to Anderson, facilitating a more precise method of choosing areas for redaction. Word 97 is also compatible with Pontin.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson

teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

In regard to dependent claim 6, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

In regard to dependent claim 8, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches “include” structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of efficient batch (all at once) processing.

In regard to claims 13-14, claims 13-14, reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, respectively, and are rejected along the same rationale.

In regard to claim 16, claim 16 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

In regard to claims 21-22, claims 21-22 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, and are rejected along the same rationale.

In regard to claim 24, claim 24 reflects the system comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

In regard to dependent claims 35-36, Anderson does not specifically teach that the above frame is a “resizable” frame. However, Word 97 teaches a document comprising text and images (Word 97 page 1), whereby a user superimposes a rectangle via AutoShapes onto a displayed document (Word 97 page 2). Please note that said rectangle can be moved and “resized” accordingly (Word 97 page 3). It is also noted that said rectangle can be made transparent, or semi-transparent (Word 97 pages 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the movable/resizable rectangle to Anderson, facilitating a more precise method of choosing areas for redaction (Word 97 is also compatible with Pontin).

Response to Affidavit under 37 CFR 1.132

7. The Affidavit under 37 CFR 1.132 filed 1/24/2007 is insufficient to overcome the rejection of the pending claims based upon the instant rejections using the Redax reference as set forth in the last Office action. The examiner respectfully notes that Applicant has failed to establish a clear nexus between the evidence of secondary considerations, and the merits of the claimed invention, for at least the following reasons:

Applicant declares on page 2 of the affidavit that Redax 1.0 was not capable of redacting images, and that said product did not meet with commercial success. Applicant asserts that commercial success of its subsequent release of Redax 1.5 was due to its new capability of redacting images along with text. This conclusion appears to be an opinion, since there exists many possible reasons for commercial success outside of what Applicant states (i.e. increased and/or more strategic advertising, inclusion as part of promotions, additional added features and compatibilities, more robust less buggy version, etc.). Although paragraph 8

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presents Redax Lite as commercially unsuccessful, it is unclear as to whether this was due exclusively to its text-only redaction capability.

Applicant asserts at paragraphs 9, and 10 of the affidavit that Redax 1.5 and newer has gained great acceptance from government customers, and widely praised in the industry. Although a list of government customers is provided, it is unclear whether this translates into actual use of the product.

Applicant presents exhibits A-K in support of professional approval in the industry. However, said exhibits merely reflect the opinions of their respective authors, not actual evidence of success.

In view of the strength of the cited art of record applied to the instant rejections, and Applicant's failure to establish a clear nexus between the evidence and the merits of the claimed invention, the examiner has determined that Applicant's declaration does not overcome the obviousness rejections of the pending claims at the present time.

Response to Arguments

8. Applicant's arguments filed 1/24/2007 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 11-12 of the amendment that the cited references do not teach independent claim 1. The examiner respectfully disagrees. It is to be noted that Pontin is no longer relied upon to teach "said output file comprising said identified information except for portions of said information corresponding...". Claims 1, 9, 17, 21 and 26 recites in part, a PDF data stream. It is respectfully submitted that Redax teaches this feature. Since a PDF file contains a set of instructions for describing content, layout, etc., it is at least obvious that editing said PDF file to produce a new PDF file results in a new saved set of instructions to reflect said editing.

Since Redax teaches that a new (PDF) document is created and saved (reflective of user editing and redacted deleted text), said new edited document reflects a new set of saved instructions (exemption codes in

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place of the deleted data) accordingly, resulting in portions of the PDF data stream (the deleted data) not present in the final document.

Applicant argues on page 12-13 of the amendment that the cited references do not teach saving designations "in association with the document". The examiner respectfully disagrees. Snagit's saving of a screenshot clearly teaches saving a designated area along with the document, in which the designation(s) are associated with the document. The examiner introduces Pontin to teach Snagit's screen-dump capability, therefore producing flattened redacted image pasted into a final document accordingly, resulting in a document with permanent image redaction. Representative claim 5 does not claim any underlying set of instructions for the designations to be saved to. Anderson teaches a user designating a geographical area for redaction, resulting in a document with said designated area redacted. Pontin teaches a final document with a pasted flattened redacted image, rendering said redaction permanent. At the very least, visual inspection of said final document reveals redacted areas designated accordingly with the document.

In additional support of the instant rejections, Anderson teaches annotation and/or redaction of objects accordingly. If a user wishes to redact the image of Texas (Anderson Figure 2B), it is at least obvious that the geographic region (square) surrounding Texas can be reasonably interpreted as "*designating a geographic region of the document for redaction*". Anderson's command entry or pull down menu includes instructions for designating location, size and orientation, which can be reasonably interpreted as manipulation of a frame (i.e. the frame of Texas). Word 97 is introduced by the examiner to teach a movable frame region.

Applicant argues on page 13-14 of the amendment that the cited art does not teach the limitations of claims 31-33. The examiner respectfully disagrees. Anderson redacts a region, which involves redacting images, and Redax teaches redacting PDF files (image based). It would have been obvious to one of ordinary skill in the art at the time of the invention that at some point, pixels are being replaced accordingly.

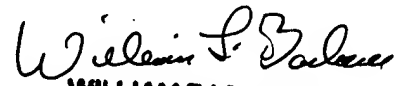
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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM BASHORE
PRIMARY EXAMINER

April 13, 2007